

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

The Examiner has not acknowledged receipt of the certified copy of the priority document. Such acknowledgment is requested. A copy of the return postcard is attached.

Claims 1, 3, 8-10, and 15-17 remain in this application. Claims 2, 4-7, and 11-14 have been withdrawn as the result of an earlier restriction requirement.

The examiner has acknowledged that claims 16 and 17 are directed to allowable subject matter. Claims 3 and 10 are objected to.

The examiner objected to claims 3 and 10 as being dependent upon a rejected base claim, but allowable if put into independent format.

Claims 1, 8, 9 and 15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gottfried *et al.* (U.S. 5,613,230) in view of De Loe, Jr. (U.S. 5,603,113). For the following reasons, the rejection is respectfully traversed.

Claim 1 recites a control signal generating means for "level-detecting the receiving signal, averaging the detected receiving signal level for a predetermined time, and then generating a feedback signal as the control signal for the gain variable amplifier". None of the references suggest this element of claim 1.

The Examiner cites De Loe as teaching the cited element of the claim at col. 1, line 65 to col. 2, line 17. However, a close reading of that passage fails to support any such teaching.

De Loe teaches averaging an AC signal to produce a DC received signal strength signal indicating a signal strength signal which is linearly proportional to the AC signal level. However, there is no suggestion that the averaging be

accomplished for a "predetermined time" as recited in the claim, and thus the references do not suggest this claim limitation. It is clear that De Loe teaches a *real-time* averaging process that does not operate for a "predetermined time" but instead operates constantly (see col. 6, lines 12-31, and FIG. 4, showing only analog circuits for averaging). The prior art reference(s) must teach or suggest *all* of the claim elements and/or claim limitations to support a prima facie case of obviousness (MPEP §2143.03). Thus, the combination fails to teach the invention, as claimed.

Further, the modification of Gottfried with De Loe's averaging process would make Gottfried inoperable for its intended purpose. Note that FIG. 1 shows that the output 42 of the AGC device used to feed the variable amplifier is also sent directly to the A/D converter, and then the controller 22. The reference states that the signal 42 is "inversely proportional to the amplitude of the RF signal" (col. 3, lines 66-67). The controller 22 then determines whether the signal 42 is less than a threshold J (col. 4, lines 27-28). However, by modifying the Gottfried device for "averaging an AC signal to produce a DC received signal strength signal indicating a signal strength signal which is linearly proportional to the AC signal level" as taught by De Loe, would alter the character of signal 42, turning it into an "averaged linear output" (col. 6, lines 27-28) and thus make the controller 22 logic inoperable as required by Gottfried. An "averaged linear output" is not truly proportional to the amplitude of the input, and thus using this De Loe signal changes the principle of operation and would thus require *additional* modifications to the controller 22 logic in order to make Gottfried operable for its intended purpose. Such modification is not suggested by either of the references. Thus, a prima facie case of obviousness has not been made, because the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.01 .

Finally, the Examiner has not provided the proper motivation for *combining* the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior

art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner has cited no support for any such suggestion or motivation for the combination from within the references, and neither does the Examiner provide any references supporting any motivation to modify the reference(s) by making the combination.

Merely listing an advantage of the combination is also not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references without some motivation to do so. The invention must be obvious "as a whole". Accordingly, the combination is improper and thus the rejection should be withdrawn.

Consequently, for each of the above reasons, taken alone or in combination, claim 1 is patentable over the references. Claims 8, 9, and 15 all contain limitations similar to those cited for claim 1, and thus those claims are patentable over the references for the same reasons. The remaining rejected or objected claims in the application depend upon one or more of claims 8, 9, or 15, and thus are patentable over the references for at least the same reasons as their parent claims.

In consideration of the foregoing analysis, it is respectfully submitted that the

Appl. No. 09/09/527,924
Amdt. Dated February 20, 2004
Reply to Office action of November 21, 2003

present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32429.

Respectfully submitted,

PEARNE & GORDON, LLP

By: 

Robert F. Bodi, Reg. No. 48,540

1801 East 9th Street, Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

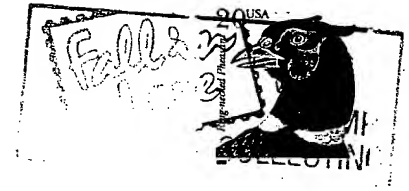
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Technology Center 2600

No. 10923

Inventor / Applicant: Nozomi Miura
Title: "AUTOMATIC GAIN CONTROL CIRCUIT AND RECEIVER"
Serial No. _____ Patent No. _____
Filed: _____ Examiner _____

Enclosed Are:

- ☒ PATENT APPLICATION (New)
- ☒ New Application Transmittal 1 copy
- ☒ Declaration & Power of Attorney
- ☒ Pgs. of Claims
- ☒ Sheet(s) of Drawing(s)
 - ☒ Formal ☐ Informal
- ☐ Small Entity Statements
- ☐ Continuation or Division
- ☐ Rule 60 ☐ FWC
- ☒ Supplemental Declaration
- ☒ ASSIGNMENT
 - ☒ Transmittal(s)
 - ☒ Original ☐ Copies
- ☐ INFORMATION DISCLOSURE
 - ☐ PTO-1449 ☐ Refs.

Other Specification - 56 pages and
abstract, PRO/5B105 FORM,
Certified copy of Jap. Pat. Appl.

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ACKNOWLEDGES RECEIPT OF:

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